

### **REMARKS/ARGUMENTS**

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

1. Rejection of Claims 1, 2, 4-26, 28-36 and 38-43 under 35 U.S.C. § 103(a).

Claims 1, 2, 4-26, 28-36 and 38-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rautila (U.S. Pat. No. 6,714,797) in view of Tarbouriech (U.S. Pat. No. 6,650,877). Claims 1, 20, 31 and 42-43 are independent.

In response, the Applicant respectfully traverses the rejection of these claims for the following reasons:

#### **Teachings of Rautila Have Been Misinterpreted**

In support of the rejection, the Examiner states that Rautila teaches a “*data marking device*”. However, the Applicant is unable to find any support for that conclusion in the Rautila reference. The Applicant respectfully submits that the Examiner has misinterpreted the Rautila reference, and that the Examiner has incorrectly concluded that the following sections of the reference teaching a data marking device:

1. Rautila Col. 1, lines 35-41:

*“Once the credit card charge is approved, the operator of the web site will then typically ship the item to the user. In the case where the item ordered is digital in format, such as software, graphics, text, video, or music, the item ordered maybe downloaded into the user's PC, server, lap top, palm computer or other processor-based system.”*

Note that the above section of Rautila describes ordering a digital item for download, which has nothing but incidental relevance to a data marking device. These teachings of Rautila manifestly lack any description of a data marking device as recited in the independent claims of the instant application. The data marking device recited in the rejected claims provides for bookmarking broadcast music clips when they are being played as described by the specification of the instant application, including the Applicant's discussion at page 1, Lines 23-35 of the Specification.

2. Rautila Col. 4, lines 40-63:

*"The electronic shop server 40 provides a menu of digital products supplied from content providers 100 available for purchase by user 20. The user 20 may directly download the digital products from the electronic shop server 40 using the cellular phone capabilities of the mobile station 10. The user may also proceed to a hotspot network 50 to download the digital product using the LPRF capability of the mobile station 10. ...Thus, the user 20 can effectively perform a cost benefit analysis of downloading to the cellular phone in the mobile station 10 versus traveling to a hotspot 50 and downloading the digital product through the much faster short range transceiver 210, shown in FIG. 2."*

The above section of Rautila describes unambiguously a shop mechanism for ordering goods and having them received through a cellular phone or depending on availability a network hotspot. There is no disclosure of anything which comports to a data marking device, also referred to as a "bookmarking" device in the instant application.

3. Rautila Col. 5, line 39 through Col. 8, line 3. Since this portion of the Rautila spans a substantial portion of the entire Rautila reference, specifically including four columns of text, it will not be duplicated below. The Examiner does not direct the Applicant to any specific elements within this section of Rautila, and the Applicant is unable to find anything within this section of Rautila which could be considered a description of a data marking device according to the specification of the instant application.

It should be recognized that the meaning of terms used in the claims is determined by the specification, and cannot be interpreted apart from those teachings.

Accordingly, the Applicant respectfully submits that Rautila does not teach what the Examiner purports the reference to teach, and, therefore, the Applicant's claims are not obvious in view of the combined teachings of Rautila and Tarbouriech. Therefore, the Applicant requests that the rejection be withdrawn and that Claims 1, 20, 31 and 42-43 (as well as the claims that depend therefrom), be allowed.

### **Applicant Has Solved a Different Problem**

The Applicant's invention solves a different problem than the cited references, and such a solution is clearly recited in the Applicant's claims. Refer to *Wright*, 6 USPQ 2d 1959 (1988). The claimed invention is directed to a data marker device communication system, and describes wirelessly communicating data marks from a data marking device (first device) to what is referred to as a network device (second device) and then through a different wireless connection to a server which the specification defines as being adapted for retrieving information about the data marks which can be accessed by a user. This is clearly not the object of the Rautila reference, as it is directed to allowing payment for downloads over the cellular network (see FIG. 4). Furthermore, the Tarbouriech reference provides a conventional connection between a data marking device and a user terminal (see FIG. 6). However, the thrust of Tarbouriech is that of detecting the broadcast frequency when collecting a data mark, wherefrom the data is communicated to a user terminal which can access a server conventionally. Neither of these references have a similar object to that brought out in the Applicant's claims. Note the following provisions of the MPEP in this regard:

MPEP 2143.01A: "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)." Emphasis added.

Accordingly, the Applicant respectfully submits that the Applicant's claims are not obvious in view of the combined teachings of Rautila and Tarbouriech. Therefore, the Applicant requests that the rejection be withdrawn and that Claims 1, 20, 31 and 42-43 (as well as the claims that depend therefrom), be allowed.

### **All Claim Limitations are Not Taught**

In considering the claims of the Applicant, it will be noted that the data marking device (first device) bookmarks a broadcast clip which is communicated wirelessly to a network device (second device). The second device then wireless communicates the information with a server. From the Applicant's Specification (see page 4, lines 22-28; page 5, lines 3-7) it is clear that the term network device (second device) used in the claim provides a mechanism for communicating wirelessly between the data marking device and a server. Also from the Applicant's Specification it is understood that the server is not the user terminal (see FIG. 1). The server is configured "*to retrieve data such as playlist data, user account information, playlist information, and the like based on data marks received*" (see page 7, line 31, through page 8, line 1), as well as to communicate through the internet with a user terminal (see page 4, lines 2-4, and so forth). According to these descriptions, it is clear that the structure recited in the Applicant's claims is not the structure which arises from the combination of the relied-upon references.

The Rautila reference is not related to a data marking device at all, but instead provides a means of charging for downloads from mobile devices using a cellular phone. Referring to the first line of the Abstract of Rautila: "*A system, method and computer program for ordering, paying for and download digital products to a mobile device in a cost-effective manner.*" There is no description of communicating data marks from a data marking device. Rautila describes connections between wireless mobile devices and hotspots that are wired to the internet wherethrough data can be downloaded which has been payed for by making a cellular phone call to a mobile network configured for accepting payment and activating downloads (see FIG. 1, FIG. 3, and FIG. 4). It will be noted that block 350 in FIG. 4 simply denotes "*payment arrangements made*" prior to downloading of content over the cellular phone or from the hotspot.

The Tarbouriech reference describes a data marking device that detects the radio frequency of the station when marking a broadcast. Tarbouriech connects directly with the user's networked personal computer, which then could connect over the internet with a server for processing the broadcast information. Accordingly, attempts to combine the teaching of Tarbouriech with Rautila would only result in providing a user terminal with a wireless link to a data marking device. The ability of the user to make a payment over the cellphone as in Rautila does not add functionality as recited in the claims. Alternatively, considering the user terminal of Tarbouriech as a hotspot, still does not change the nature of the interface between the data marking device and user terminal.

Note the following provisions of the MPEP in this regard:

**2143.03 All Claim Limitations Must Be Taught or Suggested**

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Accordingly, the Applicant respectfully submits that Rautila does not teach what the Examiner purports the reference to teach, and, therefore, the Applicant's claims are not obvious in view of the combined teachings of Rautila and Tarbouriech. Therefore, the Applicant requests that the rejection be withdrawn and that Claims 1, 20, 31 and 42-43 (as well as the claims that depend therefrom), be allowed.

**Obvious to Try, Not a Standard of Obviousness**

To support the combination of references, the Examiner asserts that "*It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Rautila to include and store a data mark in response to*

*broadcasting of a broadcast clip as taught by Tarbouriech. One of ordinary skill in the art would have been lead to make such a modification to store a data mark related to bookmarking a broadcast clip over a radio station to later recall that information related to the bookmarked music clip".*

However, a number of problems exist with this assertion. The first problem is that the combination of references does not teach all the claimed limitations. As discussed, the combination would only result in either replacing a hotspot with the network device (second device), or the connection to the PC in Tarbouriech with the mobile to hotspot connection of Rautila - neither of which singly or in combination suggests, teaches or provides motivation or incentive for the invention as claimed. The second problem is that the Examiner appears to be arguing that in light of the data marking device containing data it would be "obvious to try" combining the Rautila and Tarbouriech references toward achieving the Applicant's claimed result. However, "obvious to try" is not the standard of patentability of 35 U.S.C. 103. There is no teachings within either reference from which one of ordinary skill in the art would arrive at both the new object and structure of the claimed invention.

Therefore, a number of intractable problems exist with regard to a combination between Rautila and Tarbouriech, in particular the combination does not result in the claimed invention, while the relied upon references are drawn to different operating principles and lack suggestion for attempting the combination.

Accordingly, the Applicant respectfully submits that Rautila does not teach what the Examiner purports the reference to teach, and, therefore, the Applicant's claims are not obvious in view of the combined teachings of Rautila and Tarbouriech. Therefore, the Applicant requests that the rejection be withdrawn and that Claims 1, 20, 31 and 42-43 (as well as the claims that depend therefrom), be allowed.

#### **Claim Amendments Further Distinguish**

In order to expedite allowance, the Applicant has amended the claims to further clarify and thus further distinguish over the cited references. In the rejection, the

aspects of the network device and server were misconstrued. The amendments of the independent claims recite the relationships of these elements and the user terminal in more precise terms according to the specification.

The amendments clearly recite the use of a first and second communication channel through which the data mark is communicated, and that these channels are supported by a first and second device, as well as a server. The server is further described for retrieving playlist data in response to receipt of the data mark from the first device and thus through the first and second wireless communication channels. In addition, it is the server to which the user terminal can connect over a data network for accessing playlist data of the user account on said server.

These elements clarify the claims while further distinguishing over the cited references. Neither reference, singly or in combination, suggests, teaches or provides motivation or incentive for the invention recited in the Applicant's claims.

Accordingly, the Applicant respectfully submits that Rautila does not teach what the Examiner purports the reference to teach, and, therefore, the Applicant's claims are not obvious in view of the combined teachings of Rautila and Tarbouriech. Therefore, the Applicant requests that the rejection be withdrawn and that Claims 1, 20, 31 and 42-43 (as well as the claims that depend therefrom), be allowed.

2. Rejection of Claims 3, 27 and 37 under 35 U.S.C. § 103(a).

Claims 3, 27 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rautila (U.S. Pat. No. 6,714,797) in view of Tarbouriech (U.S. Pat. No. 6,650,877), and further in view of Lehtonen (U.S. Publ. No. 2001/0049262).

In response, the Applicant notes that Claims 3, 27 and 37 are dependent claims and are allowable for the same reasons as with regard to their base claims.

3. Amendment of Claims 1, 4-7, 9-15, 17-19, 20-22, 25 and 28-43.

(a) Claims 1, 20, 31, 42-43.

The Applicant has amended independent Claims 1, 20, 31 and 42-43 to clarify the use of the first and second devices as well as the server and its relation with the user terminal.

The term wireless connection is used instead of communication path to keep a consistency through the claims. The term "network device" was dropped in deference to "second device", as the term "network device" was being confused with the server which is a internet coupled network device. The term "server terminal" was replaced with "server" for consistency and to eliminate any confusion with the functions of the "user terminal".

The claims describe a first and second wireless connection, support for which can be seen in FIG. 2 block 303 of the I/O interface with device 102 shown configured for establishing a first and second communication 106, 107.

The server is further described for retrieving playlist data and for communicating with the user terminal so it can access the playlist data, support for which is found throughout the specification, such as at page 7, lines 30-32 and elsewhere.

Support for retrieving information corresponding to the data marks, as found in claims 20, 31, 42 and 43 was previously found in Claim 28, while retrieval from a storage unit is shown in FIG. 4 block 405 and described throughout the text.

Claim 1 describes the first wireless connection as being "local and short-range", support for which is found in the specification, including page 3, lines 32-33; page 4, line 10; and so forth.

(b) Claims 4-7, 9-15, 17-18, 21-22, 25, 30, 32, 34-37 and 41. This group of dependent claims were amended to maintain proper antecedent basis and consistency with their respective base claims.

(c) Claim 19. Dependent Claim 19 was amended to recite that the broadcast information contains one or more of these elements, which is recited in other dependent



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claims, such as Claim 30, as well as in the specification, including page 1, lines 23-35; page 8, line 18-24; page 9, lines 10-15 and so forth.

(d) Claims 28-29, 33 and 38-40. These dependent claims were canceled.

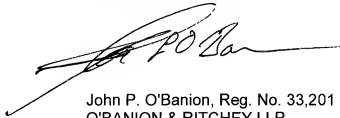
4. Conclusion.

Based on the foregoing, Applicant respectfully requests that the various grounds for rejection in the Office Action be reconsidered and withdrawn with respect to the presently amended form of the claims, and that a Notice of Allowance be issued for the present application to pass to issuance.

In the event any further matters remain at issue with respect to the present application, Applicant respectfully requests that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this application.

Date: 9/19/06

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John P. O'Banion", with a long horizontal flourish extending to the right.

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